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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,589

06/25/2003

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EXAMINER

DICKERSON, CHAD S

ART UNIT

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2625

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/603,589	Applicant(s) KURAHASHI ET AL.	
	Examiner CHAD DICKERSON	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 7296791.

Regarding claim 1, it is noted that although the conflicting claims are not identical, they are not patentably distinct from each other because:

- claim 1 of the instant application and claim 5 of Pat ‘791 both recite an image formation job and the formation of an image in accordance to the image data;
- the conveying device that conveys sheets in claim 1 of the instant application is disclosed through the discharging device in claim 5 of Pat ‘791 (see col. 66);

- the feature of having the container capable of being transported to another image forming device with stacked sheets and used in the different image forming device of claim 1 of the instant application is disclosed in claim 5 of Pat '791;
- the last feature of having a writing device write information for processing the stacked sheet in the container with the different image forming device into a memory of claim 1 of the instant application is disclosed in claim 5 of Pat '791 with the information on the storage device pertaining to the stored sheets, such as the page order to inform the other apparatus that receives the container the page order of the sheets in the container;
- Whereby claim 1, which recites the open ended transitional phrase “comprising”, does not preclude the additional elements recited by claim 5, and
- Whereby the elements of claim 1 are fully anticipated by claim 5 of Pat '791, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Regarding claim 2, it is noted that although the conflicting claims are not identical since claim 5 of Pat '791 lists additional features not required by claim 2 of the instant application, they are not patentably distinct from each other because:

- claim 5 of Pat '791 recites an identification of an image formation job as the information written in the storage device and this information fully anticipates the image forming job as claimed in claim 1 of the instant application;

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- Whereby the elements of claim 2 are fully anticipated by claim 5 of Pat '791, and anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Regarding claim 3, it is noted that although the conflicting claims are not identical since claim 5 of Pat '791 lists additional features not required by claim 3 of the instant application, they are not patentably distinct from each other because:

- Claim 5 of Pat '791 recites the storing, or writing of, information related to the sheet size of sheets stored in the container and this information fully anticipates the claimed feature in claim 1 of the instant application;
- Whereby the elements of claim 3 are fully anticipated by claim 5 of Pat '791, and anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Regarding claim 4, it is noted that although the conflicting claims are not identical since claim 5 of Pat '791 lists additional features not required by claim 4 of the instant application, they are not patentably distinct from each other because:

- Claim 4 of the instant application and claim 5 of Pat '791 recite common subject matter;

- Whereby the elements of claim 4 are fully anticipated by claim 5 of Pat '791, and anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

3. Claims 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 7296791 in view of Keithley '375 (USP 6862375).

Claim 5 of Pat '791, while disclosing the claim features of independent claim 1, fails to teach the feature of writing at least one selected from the group consisting of information for distinguishing a sheet with an abnormality and information for distinguishing a set of sheets that include a sheet with an abnormality.

Similar to the system of Pat '791, the Keithley '375 system is able to have a computer send information to a printing system for outputting a print job. Since both involve receiving a job and performing an output operation, these inventions can be determined to be in the same field of endeavor. However, the Keithley reference identifies a skew associated with a sheet that is being fed into the system and the controller (47) is used to record this information to correct the skew associated with the sheet. The skew of the document is stored, or written, in the skew table (51) and this information can be used to correct the skew of a certain document when multiple copies are required in the system (see fig. 1; col. 3, ln 10 - col. 4, ln 12 and col. 5, ln 61 - col. 6, ln 6).

Therefore, in view of Keithley '375, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of writing at least one selected from the group consisting of information for distinguishing a sheet with an abnormality and information for distinguishing a set of sheets that include a sheet with an abnormality, incorporated in the device of Pat '791, in order to detect the skew of sheet media and compensate for the sheet feed skew (as stated in Keithley '375 col. 1, ln 65-68 and col. 2, ln 1-6).

Claim 6 of Pat '791, while disclosing the claim features of independent claim 1, fails to teach the feature of wherein the abnormality is at least one abnormality selected from the group consisting out of multiply feeding or skewing of sheets, registration misalignment, and color abnormality after image formation.

Similar to the system of Pat '791, the Keithley '375 system is able to have a computer send information to a printing system for outputting a print job. Since both involve receiving a job and performing an output operation, these inventions can be determined to be in the same field of endeavor. However, the Keithley reference identifies a skew associated with a sheet that is being fed into the system and the controller (47) is used to record this information to correct the skew associated with the sheet. The skew of the document is stored, or written, in the skew table (51) and this information can be considered as an abnormality identified by the system that discloses the above claimed feature (see fig. 1; col. 3, ln 10 - col. 4, ln 12 and col. 5, ln 61 - col. 6, ln 6).

Therefore, in view of Keithley '375, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein the abnormality is at least one abnormality selected from the group consisting out of multiply feeding or skewing of sheets, registration misalignment, and color abnormality after image formation, incorporated in the device of Pat '791, in order to detect the skew of sheet media and compensate for the sheet feed skew (as stated in Keithley '375 col. 1, ln 65-68 and col. 2, ln 1-6).

4. Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 7296791.

Regarding claim 8, it is noted that although the conflicting claims are not identical since parent claim 6 provides additional features not required by claim 8 in the instant application, they are not patentably distinct from each other because:

- the feeding device that feeds sheets stored in a container that is detachably attached to an image forming apparatus is disclosed in the independent claim 6, which claim 12 depends on and this discloses the feature of claim 8 in the instant application;
- the feature of having images on the sheets stored in a container are formed in a different image forming apparatus and the container is capable of being transported to a different image forming apparatus is also performed in claim 6, which claim 12 depends on and this discloses another feature of claim 8 in the instant application;

- a reading device that reads information written into a memory in the container and a control device that controls the feeding device based on the information read by the reading device to feed the sheets stored in the container to the image forming apparatus is disclosed in claim 12 in Pat '791, which discloses the feature of claim 8 in the instant application;
- Whereby the elements of claim 8 are fully anticipated by claim 12 of Pat '791, and anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

5. Claim 26 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 7296791.

Regarding claim 26, it is noted that although the conflicting claims are not identical since parent claim 5 provides additional features not required by claim 26 in the instant application, they are not patentably distinct from each other because:

- claim 26 of the instant application and claim 5 of Pat '791 both recite an image formation job and the formation of an image in accordance to the image data;
- the conveying device that conveys sheets in claim 26 of the instant application is disclosed through the discharging device in claim 5 of Pat '791 (see col. 66);
- the feature of having the container capable of being transported to another image forming device with stacked sheets and used in the different image forming device of claim 26 of the instant application is disclosed in claim 5 of Pat '791;

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- the feature of having a writing device write information for processing the stacked sheet in the container with the different image forming device into a memory of claim 26 of the instant application is disclosed in claim 5 of Pat '791 with the information on the storage device pertaining to the stored sheets, such as the page order to inform the other apparatus that receives the container the page order of the sheets in the container for processing the sheets;
- Whereby claim 26, which recites the open ended transitional phrase “comprising”, does not preclude the additional elements recited by claim 5, and
- Whereby the elements of claim 26 are fully anticipated by claim 5 of Pat '791, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

6. Claim 27 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 7296791.

Regarding claim 27, it is noted that although the conflicting claims are not identical since claim 11 contains additional claim features not required by claim 27, they are not patentably distinct from each other because:

- claim 27 recites the function of transporting a container from one apparatus to another apparatus, which is also recited in claim 6 that claim 12 depends on;
- claim 27 recites the function of a memory containing information related to the stacked sheets is disclosed in claim 6 that claim 12 depends on;

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- claim 27 recites that function of reading information stored on memory and controlling the function of feeding the sheets in order to process the stacked sheets in accordance with the information on the memory and claim 12 recites the features of reading information on the memory and the controlling of feeding of sheets into an image forming device;
- Whereby claim 27, which recites the open ended transitional phrase “comprising”, does not preclude the additional elements recited by claim 12, and
- Whereby the elements of claim 27 are fully anticipated by claim 12 of Pat ‘791, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Mendel ‘544 discloses the feature of having a container or bin transported from one image forming apparatus to another (see col. 2, ln 52-65 and col. 21, ln 30-55).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAD DICKERSON whose telephone number is (571)270-1351. The examiner can normally be reached on Mon. thru Thur. 9:00-6:30 Fri. 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571)-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D./

/Chad Dickerson/

Examiner, Art Unit 2625

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625